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5514	7590	04/06/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			FLETCHER, JAMES A	
			ART UNIT	PAPER NUMBER
			2615	
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8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/467,174	TSUJIMOTO, SHINICHI
	Examiner	Art Unit
	James A. Fletcher	2615

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 January 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 10-15,17,19,21 and 36-57 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 10-15,17,19,21 and 36-57 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Specification***

1. The substitute specification filed 28 January 2004 has been entered.

***Response to Arguments***

2. Applicant's arguments filed January 28, 2004 have been fully considered but they are not persuasive.

**In re page 14**, applicant's representative states "Nowhere is the Hashimoto '371 patent understood to disclose or suggest the recited features including inputting original location information, converting the original location information to second (and/or third) location information, and then recording both the original location information and the converted second location information in the recording medium, where the recording medium included a picture-taking image and (original) location information associated with the picture-taking image recorded therein, e.g., by a camera, as disclosed and claimed in the present application."

The examiner respectfully disagrees, and will address each perceived deficiency in Hashimoto in turn.

Hashimoto clearly allows for inputting original location information, as it includes a GPS receiver for the expressed purpose of inputting and recording location information to the recording medium. See Col 3, lines 1-21.

Hashimoto also clearly allows converting the original location information to second and third location information such as through Web sites. See Col 6, lines 46-55.

Hashimoto further discloses recording the original location information and the second location information into the original recording medium from the camera, as noted in Col 3, lines 18-21, which define the storage media, Col 5, lines 7-10 indicate that the media is transferred to a computer for connection to the Web sites, and Fig 2, item 209 shows that Original Image Data and Map Data are stored on the storage media.

Regarding the applicant's representative's statement that such location information is recorded by a camera, such a feature is not claimed in the application. The application claims that the second and subsequent location information is recorded later onto the original media used in the camera, but does not claim that the camera records the information.

**In re page 15**, applicant's representative states that the Hashimoto patent merely teaches that the apparatus does not need to have a search code to search 'home page,' and is not related to recording of the original location information and the converted location information as claimed in the application.

The examiner notes that the reference was a disclosure that location data would not be recorded, and therefore a suggestion that second location data would not be recorded.

**Further in re page 15**, applicant's representative states that the Nealon '635 patent fails to disclose that the photo-finishing system for recording is stored in the film along with the original instructions and the new or modified instructions.

The examiner respectfully disagrees. Nealon clearly states that the updated data is "transmitted to the photofinishing system 420 for recording on the film." Nealon makes no suggestion that the original instructions or the image are deleted when the updated recording is made.

**In re pages 15 and 16**, applicant's representative states, "the Funazaki '458 patent neither discloses or suggests recording in a converted representation form into the same recording medium from which original information has been read/input, as disclosed and claimed in the present application."

The examiner respectfully notes that this assertion was not made by the examiner, and used the reference in an obvious combination to indicate that auxiliary data could be recorded on a magnetic layer of a film.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10, 13-15, 17, 19, 21, 36, 38, 39-40, 42-44, 46-49, and 51-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto et al (6,507,371).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

Art Unit: 2615

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

**Regarding claims 10, 17, 19, and 21,** Hashimoto et al disclose an apparatus and method comprising:

- an input device for inputting, from a camera detachable image recording medium into which a picture-taking image and location information associated with the picture-taking image are recorded by a camera, the location information as original information (Col 2, lines 55-63 "a memory system such as a hard disk drive [HDD] or magneto-optical disk [MO]...and a bus connecting the above units");
- a conversion device for converting the original information input by the input device to second information in a predetermined representation form (The second embodiment, beginning on Col 4, line 30, discloses a means and method of using the existing location information to look up a more descriptive location information via the Internet. Also note Fig. 15.);
- a recording device for recording the second location information converted by the conversion device into the camera detachable image recording medium in association with the corresponding picture-taking image (See Fig 5B, item 310, which indicates the storage of this information. Also see Col 5, lines 37-39, which is a text description of this figure.).

**Regarding claim 13**, Hashimoto et al disclose an apparatus further comprising a selection device for selecting a representation form in which the recording device records into the image recording medium (Col 4, lines 46-48 "it is possible to gradually expand a range...in accordance with a conversion table").

**Regarding claim 14**, Hashimoto et al disclose an apparatus wherein the input device inputs latitude and longitude information as the original information (Col 4, lines 36-37 "This embodiment basically shows the pieces of information for latitude and longitude").

**Regarding claim 15**, Hashimoto et al disclose an apparatus wherein the conversion device converts the location information to at least one representation form of a character form, a code form, and a latitude and longitude form (Col 5, lines 50-51 "Position information is change to the above city name or the like").

**Regarding claims 36 and 40**, Hashimoto et al disclose an apparatus wherein the recording device records the second location information and the original information (See Fig 5B, item 310, which indicates the storage of this information. Also see Col 5, lines 37-39, which is a text description of this figure.).

**Regarding claims 38 and 42**, Hashimoto et al disclose an apparatus wherein the converting device converts the original information to at least one representation form selected from the group consisting of a character form, a code form, or a latitude and longitude form (Col 5, lines 50-51 "Position information is change to the above city name or the like").

**Regarding claims 39 and 43**, Hashimoto et al disclose an apparatus wherein the input device inputs location information in latitude and longitude form as original information (Col 4, lines 21-23 "it is possible to obtain not only latitude and longitude information but also altitude information from a GPS" and Col 4, lines 55-56 A digital camera with a GPS is used as the image recording apparatus of this embodiment").

**Regarding claims 44, 49, and 54-57**, Hashimoto et al disclose an apparatus and method comprising:

- an input device for inputting, from a camera detachable image recording medium into which a picture-taking image and location information associated with the picture-taking image are recorded by a camera, the location information as original information (Col 2, lines 55-63 "a memory system such as a hard disk drive [HDD] or magnetooptical disk [MO]...and a bus connecting the above units");
- a conversion device for converting the original information input by the input device to second and third information in a predetermined representation form (The second embodiment, beginning on Col 4, line 30, discloses a means and method of using the existing location information to look up a more descriptive location information via the Internet. Also note Fig. 15. Further, that embodiment indicates that several derived locations can be selected, as indicated in Col 4, lines 46-48 "it is possible to gradually expand a range like 'YOKOHAMA,' 'KANAGAWA,' 'KANTO,' and 'JAPAN'");

- a selection device for selecting one or a plurality of the second and third location information converted by the conversion device (Fig 8 indicates a plurality of area classifications that can be selected, and Figs 7A-7D indicate a plurality of types of location information that may be selected); and
- a recording device for recording the second and third location information converted by the conversion device into the camera detachable image recording medium in association with the corresponding picture-taking image (See Fig 5B, item 310, which indicates the storage of this information. Also see Col 5, lines 37-39, The data section 310 stores image control data, original image data, map data...position-home-page conversion table, and retrieval homepage address data".).

**Regarding claims 47 and 52**, Hashimoto et al disclose an apparatus wherein the converting device converts the original information to at least one representation form selected from the group consisting of a character form, a code form, or a latitude and longitude form (Col 5, lines 50-51 "Position information is change to the above city name or the like").

**Regarding claims 48 and 53**, Hashimoto et al disclose an apparatus wherein the input device inputs location information in latitude and longitude form as original information (Col 4, lines 21-23 "it is possible to obtain not only latitude and longitude information but also altitude information from a GPS" and Col 4, lines 55-56 A digital camera with a GPS is used as the image recording apparatus of this embodiment").

**Regarding claim 46 and 51, Hashimoto et al disclose an apparatus comprising a selecting device for selecting whether or not the original location information is recorded (Col 7, line 18 "There is a method of inputting no data" and Col 4, lines 16-17 "location information intentionally related by a user can be used").**

***Claim Rejections - 35 USC § 103***

**5.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6.** Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al as applied to claim 10 above, and further in view of Nealton (5,023,635).

**Regarding claim 11, although Hashimoto et al suggest an apparatus that further comprises a selection device for selecting whether the location information in the predetermined representation form converted by the conversion device is recorded into the image recording medium along with the original information or not (Col 7, line 18 "There is a method of inputting no data"), they do not specifically disclose storing determined data along with original data.**

Nealton teaches optionally storing new data along with existing data (Col 7, lines 51-55 "the order entry station plays back the new or modified instructions it now stores, which are transmitted to the photofinishing system for recording"). As suggested by Hashimoto et al and taught by Nealton, being able to store the original data along with

the new data permits the original data to be retrieved without degradation or distortion. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a means for determining whether original and derived data would be stored together or not.

7. Claims 37, 41, 45, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al as applied to claims above, and further in view of Nealton.

**Regarding claims 37 and 41,** Hashimoto et al suggest an apparatus comprising a selecting device for selecting whether or not the second location information is recorded into the image recording medium together with the original information (Col 7, line 18 "There is a method of inputting no data"), but they do not specifically disclose storing second data along with original data.

Nealton teaches optionally storing new data along with existing data (Col 7, lines 51-55 "the order entry station plays back the new or modified instructions it now stores, which are transmitted to the photofinishing system for recording").

As suggested by Hashimoto et al and taught by Nealton, being able to store the original data along with the new data permits the original data to be retrieved without degradation or distortion.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a means for determining whether original and derived data would be stored together or not.

**Regarding claims 45 and 50**, Hashimoto et al suggest an apparatus comprising a selecting device for selecting whether or not the second and third location information is recorded into the image recording medium together with the original information (Col 7, line 18 "There is a method of inputting no data"), but they do not specifically disclose storing second data along with original data.

Nealton teaches optionally storing new data along with existing data (Col 7, lines 51-55 "the order entry station plays back the new or modified instructions it now stores, which are transmitted to the photofinishing system for recording").

The examiner takes official notice that recording a third data derived from an original data is an obvious extension of recording a second data derived from an original data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a selection for storing second and third data.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al as applied to claim 10 above, and further in view of Funazaki.

**Regarding claim 12**, although Hashimoto et al suggest an apparatus wherein the input device inputs the original information that is magnetic recorded on a film (Col 3, line 65- Col 4, line 3 "Image and location information can be recorded in an analog recording medium such as a silver film or a digital recording medium such as a flash memory"), they do not specifically disclose the use of a magnetic recording on a film medium.

Funazaki teaches the storage of auxiliary photographic data on a magnetic area of a photographic film (Col 4, lines 20-24 "the processor controls a procedure for recording the shooting conditions selected and the data read out of the ROM in the magnetic recording area of the film via the magnetic head"). As suggested by Hashimoto et al and taught by Funazaki, storing of auxiliary photography data such as location data on a magnetic track on a film permits a high quality image storage with additional data in a format where the image and the data are preserved together. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to record location data on a magnetic portion of a film.

***Conclusion***

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**10.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (703)

305-3464. The examiner can normally be reached on 7:45AM - 5:45PM M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached at (703) 308-9644.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, DC 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only).**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JAF  
April 5, 2004

*Vincent Boccio*  
VINCENT BOCCIO  
PRIMARY EXAMINER